

Appln. Serial No. 10/800,055
Reply to Office Action Mailed May 22, 2006

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REMARKS

In the Office Action dated May 22, 2006, claims 1, 11, 13, 15-23, and 25-30 were rejected under 35 U.S.C. § 102 over U.S. Patent No. 6,311,069 (Havinis '069); claims 7-8 were rejected under § 103 over Havinis '069 in view of U.S. Patent No. 6,195,557 (Havinis '557); claims 3-5 were rejected under § 103 over Havinis '069; and claims 9, 12, and 14 were rejected under § 103 over Havinis '069 in view of Havinis '557 and "Applicant's admitted prior art" (APA) (Pub. No. US 2004/0180655).

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IMPROPER FINAL REJECTION.

The finality of the present Office Action is improper. In the previous amendment, claim 8 was amended from dependent form to independent form, with the scope of claim 8 remaining *unchanged*. Original claim 8 depended from claim 6, which in turn depended from claim 1. Claim 8 was amended previously to incorporate the subject matter of claim 1 and intervening claim 6. No amendment to the scope of claim 8 was made.

In the previous Office Action (dated November 2, 2005), claim 8 was rejected as being anticipated by Havinis '069. 11/2/2005 Office Action at 2. However, even though the scope of claim 8 has not been changed, the present Office Action issued a new ground of rejection against claim 8 (claim 8 rejected as obvious over Havinis '069 and Havinis '557). The new ground of rejection against claim 8 was *not* necessitated by an amendment made by Applicant since claim 8 was merely amended from dependent form to independent form, with its scope remaining unchanged. Therefore, withdrawal of the finality of the Office Action is respectfully requested.

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REJECTION UNDER 35 U.S.C. § 102.

Independent claim 1 was rejected as being anticipated by Havinis '069. Claim 1 recites a method that comprises communicating, to a mobile station, a paging message *containing an indication* of whether the paging message is related to at least one of an emergency-related location service and a law enforcement-related location service, where the indication has a first state to indicate that the paging message is related to at least one of the emergency-related location service and law enforcement-related location service.

The Office Action identified the positioning request 285 and the DTAP request message 275 disclosed by Havinis '069 as being the paging message of claim 1. However, the Office Action conceded that the request message 275 is *not* sent to the mobile station when the location application (LA) 280 is an emergency application or a law enforcement application. *See* Havinis '069, 7:40-44; *see also* 5/22/2006 Office Action at 5 (recognizing that the request message 275 is not sent to the mobile station if the LA 280 is an emergency application or a law enforcement application). This concession by the Office Action necessarily means that the request message 275 cannot constitute the paging message of claim 1, since the paging message of claim 1 contains an indication of whether the paging message is related to at least one of an emergency-related location service and a law enforcement-related location service, where the indication has a first state to indicate that the paging message is related to at least one of the emergency-related location service and a law enforcement-related location service.

However, the Office Action argued that, due to the override capability of an emergency application or a law enforcement application, the positioning request 285 of Havinis '069 is sent to the mobile station, not the request message 275. 5/22/2006 Office Action at 3. The statement that the positioning request 285 is sent to the mobile station is incorrect. Fig. 5 of Havinis '069 clearly shows that the LA 280 sends the positioning request 285 to the GMLC 290, which in turn sends the positioning request 285 to the MSC. However, the MSC does *not* send the positioning request 285 to the mobile station. The Office Action has not cited to any specific passage in Havinis '069 which specifically teaches that the positioning request 285 is sent to the mobile station.

In addition, the Office Action stated that the mobile station "has to be paged in order to be positioned." 5/22/2006 Office Action at 3. The fact that the mobile station is paged to be positioned does not mean that the positioning request 285 is sent to the mobile station. In fact, in

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column 8 of Havinis '069, reference is made to the VLR 16 performing paging and authentication of the mobile station if the mobile station is in idle mode. Havinis '069 8:8-12. There is absolutely no indication that this paging of the mobile station described in column 8 of Havinis '069 differs from any conventional paging; in other words, the paging message sent by the VLR 16 to the mobile station, as taught by Havinis '069 in column 8, would *not* include the indication recited in claim 1, since the paging message is a conventional paging message.

In view of the foregoing, it is respectfully submitted that claim 1 is clearly not anticipated by Havinis '069.

Independent claims 15, 22, and 27 are similarly allowable over Havinis '069.

Independent claim 18 was also rejected as anticipated by Havinis '069. Claim 18 recites an article comprising a storage medium that contains instructions that when executed cause a *mobile station* to receive a location request on the traffic channel containing an indication that the location request is related to at least one of an emergency-related location service and a law enforcement-related location service. The Office Action cited column 2, lines 47-50, and column 5, lines 27-30, and lines 50-52, of Havinis '069 as disclosing this receiving element of claim 18. 5/22/2006 Office Action at 8. The passage at column 2, lines 47-50, refers to the community interest in positioning a mobile station for an emergency or law enforcement location application that outweighs the subscriber's need for privacy. The cited column 5 passages refer to a positioning request 285 as received by a *mobile switching center 14 (not a mobile station)*, and the mobile switching center 14 comparing the LA identity information in a subscriber's SLPP (subscriber privacy profile) that is downloaded to the visitor location registry or VLR 16 with the LA identity provided with the received positioning request 285 from the location application. There is absolutely no teaching in these column 5 passages of Havinis '069 of a *mobile station* receiving a location request on a traffic channel containing an indication that the location request is related to an emergency-related location service or a law enforcement-related location service. In fact, Havinis '069 specifically teaches that the mobile station is *not* to receive a request message 275 if the location application is an emergency application or a law enforcement application. Havinis '069, 7:40-45.

Dependent claims are allowable for at least the same reasons as corresponding independent claims. Moreover, in view of the allowability of base claim 1 over Havinis '069, it

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is respectfully submitted that dependent claim 7 is allowable over Havinis '069 and Havinis '557.

REJECTIONS UNDER 35 U.S.C. § 103

Independent claim 8 was rejected as being obvious over Havinis '069 and Havinis '557. It is respectfully submitted that the hypothetical combination of Havinis '069 and Havinis '557 does not teach or suggest the claimed subject matter. The Office Action conceded Havinis '069 does not disclose communicating a paging request containing the indication from the mobile switching center to a base station. However, the Office Action relied upon Havinis '557 as disclosing the communicating of such a paging message. 5/22/2006 Office Action at 13. Specifically, the Office Action cited column 6, line 62 through column 7, line 2, of Havinis '557 as disclosing this feature of claim 8. Although the cited passage of Havinis '557 does state that the MSC/VLR 360 can forward a positioning request to a base station controller, there is no teaching in Havinis '557 of the mobile switching center *setting* a state of the indication in the paging request (sent from the mobile switching center to the base station) based on the field contained in the position request for indicating whether the position request is related to at least one of the emergency-related location service and the law enforcement-related location service.

The Office Action further cited to column 5, lines 50-52 of Havinis '069 as teaching the mobile switching center setting an indication in such a paging request. However, this cited passage of Havinis '069 refers to the position request 285 received from the location application 280 containing an identity of the location application. However, nowhere in this cited passage is there any suggestion of a mobile switching center setting a state of the indication in the paging request sent from the mobile switching center to a base station based on a field contained in the position request, as recited in claim 8.

Since the hypothetical combination of Havinis '069 and Havinis '557 does not teach or suggest all elements of claim 8, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 8 and its dependent claims.


In view of the allowability of base claim 8 over Havinis '069 and Havinis '557, it is respectfully submitted that the obviousness rejection of dependent claims over Havinis '069, Havinis '557 and an APA has also been overcome.

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In view of the foregoing, allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0118US).

Respectfully submitted,

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